

REMARKS

Prior to this Amendment, claims 1-7 were pending in the application. Claims 3-7 are canceled herein without prejudice or disclaimer. Claims 1 and 2 are amended. Applicant introduces new claims 8 – 13. The amendments find support in the specification and are discussed in the relevant sections below. No new matter is added.

35 U.S.C. §112, Second Paragraph Rejection

The Examiner has rejected claims 1 and 2 as being indefinite, and suggests amending claim 1 to claim a compound. The Examiner further states that the term ‘derivative’ is ambiguous, and further suggests that the term be replaced with “compounds”.

As suggested by the Examiner, Applicant has amended claim 1 to claim a “5-benzoylamino-1,3-dioxacyclane compound...” Claims 1 and 2 have been further amended such that the term ‘derivative’ no longer appears in the claims. As such, Applicant submits that claims 1 and 2, as amended, are definite and request reconsideration of the claims.

The Examiner has rejected claim 3 under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps. The Examiner suggests inserting the necessary steps into the claim.

Applicant has canceled claim 3, rendering the rejection moot. Applicant further introduces claim 8, which includes essential steps as suggested by the Examiner. The steps find support within the Specification, for example, on pages 9 through 11.

As such, Applicant respectfully requests withdrawal of the 35 U.S.C. §112, second paragraph rejection and reconsideration of claims 1-3.

35 U.S.C. §102 Rejection

The Examiner has rejected claims 1 – 2 under 35 U.S.C. §102(b) as allegedly anticipated by Bi et al (2000). The Examiner states that Bi teaches species according to the invention, in particular compounds of formulas 5-8, 9, 11, 13, and 10.

The Examiner has rejected claims 1-2 under 35 U.S.C. §102(b) as allegedly being anticipated by Bi et al. (2002). The Examiner alleges that formula 12 on page 24 of the Bi et al. (2002) reference discloses a species according to the invention.

With this Amendment, independent claim 1 has been amended to recite compounds of formulas 22-37 and 39-48. Applicant submits that neither of the Bi references discloses or suggests compounds of formulas 22-37 and 39-48. As such, Applicant asserts that the instant claims are novel and nonobvious over Bi et al., and request withdrawal of the rejection.

The Examiner has further rejected claims 3 – 7 under 35 U.S.C. §102(b) as allegedly being anticipated by Bi et al (2000). The Examiner states that Bi teaches the claimed process for preparing the compounds.

Applicant notes that claims 3 – 7 have been canceled. Applicant further submits that new independent claim 8, which replaces claim 3, is novel and nonobvious over Bi. As previously stated, Applicant submit that Bi does not teach or suggest the compounds of claim 1, as is currently amended. Therefore, Applicant submits that Bi does not teach how to make the compounds as recited in claim 1. Furthermore, Applicant asserts that Bi does not teach or disclose “reacting the N-benzoylaminoglycol … with p-nitro benzaldehyde or phenylacrylaldehyde in a mechanism of stereo-specific acetal transfer reaction in the presence of p-nitrobenzenesulfonic acid...” as is required in claim 8. Rather, Bi discloses stereoselective transacetylation (See, for example, Abstract and Introduction) using N-benzoylaminoglycol and 1,1,3,3-tetramethoxypropane as reactanct, and further discloses using p-toluene sulfonic acid as catalyst (See, for example, paragraph 2 in Results and Discussion). As such, Applicant respectfully requests withdrawal of the rejection.

Applicant submits that all claims are allowable as written and respectfully request early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney/agent of record.

Respectfully submitted,

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Name: Ralph Loren
Registration No.: 29,325
Customer No.: 29933
Palmer & Dodge LLP
111 Huntington Avenue
Boston, MA 02199-7613
Tel: 617-239-0100